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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,342	05/29/2001	I-Wen Winnie Tsou	078525.0103	7717
5073	7590	05/01/2008	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			BEKERMANN, MICHAEL	
			ART UNIT	PAPER NUMBER
			3622	
			NOTIFICATION DATE	DELIVERY MODE
			05/01/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 09/870,342	<b>Applicant(s)</b> TSOU ET AL.	
	<b>Examiner</b> MICHAEL BEKERMAN	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6 and 8-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6 and 8-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/13/2007</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 1/30/2008 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1, 8, 14, 19, 29, and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 1**, this claim recites the limitation "presence information for said first instant messaging user", and later recites "transmitting all or part of said business information as presence information". It is unclear if the presence information of the user is supposed to have any correlation to the business information that is transmitted as presence information. Is one presence information supposed to replace the other?

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**Regarding claim 8**, this claim recites the limitation “wherein one or more instant messaging users”. It is unclear if the first instant messaging user of the parent claims is to be included in the one or more recited in this claim. Does the first instant messaging user satisfy this limitation?

**Regarding claims 14 and 29**, this claim recites the limitation “ticker-type display”. It is unclear whether this refers to a ticker display, or whether it is simply a type of ticker display, and what properties does a display of “ticker type” have?

**Regarding claim 14**, this claim recites the limitation “displaying one of more of the following: text, a ticker-type display, wherein said display scrolls; an animation; images; and links to web sites on the Internet”. This appears to be a sentence fragment and it is unclear what exact limitations are required by the claim language.

**Regarding claim 19**, this claim recites the limitation “and a database of click statistics”. Is this limitation intended to be part of the Markush listing? It appears to simply be stated in the middle of the claim, with no reasoning as to why it’s there.

**Regarding claim 29**, this claim recites the limitation “wherein said link is to other parts of the presence information”. Claim 28, from which claim 29 depends, recites the limitation “includes a link to advertisements for said business”. Claim 29 improperly limits claim 28, as claim 28 already states the link as being directed towards advertising information. Limitations in parent claims can't be changed, only further limited.

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**Regarding claim 32**, this claim recites the limitation “said physical location information of said business”. There is insufficient antecedent basis for this limitation in the claim language.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 4-6, 8-30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179).**

**Regarding claims 1, 2, 6, 18, 20**, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a “business client system device”. The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39).

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions,

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email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

**Regarding claim 4**, the user must first turn the wireless device on before receiving any messages. This is a step of clicking (or pressing) an "On" button.

**Regarding claim 5**, De Vries teaches receiving presence information when they are at a particular location (Column 11, Lines 46-54). If the device is not at that particular location (out of range), the user must move the device within range to permit transmission of the presence information.

**Regarding claims 8-12, 14**, De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7,

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Line 44 - Column 8 Line 5). Any display of text indicating a user's presence is considered an "icon".

**Regarding claim 13**, if the first user is at a merchant location, this will be displayed to the other buddy list users independent of any selection (whether a user selects such information or not).

**Regarding claims 15-17**, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). A user profile must inherently contain contact information (IP Address or other such device identifying information) in order to receive messages to the wireless device. Turning on the device reads on enabling the wireless device.

**Regarding claim 19**, De Vries teaches storing a name database (Column 13, Lines 31-46).

**Regarding claims 21, 24, 25 and 27**, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

**Regarding claims 22 and 23**, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). By submitting profile information, a user inherently “agrees” to submit the profile.

**Regarding claim 26**, the user activity preference report must be in some form of printed text information to be understood by users.

**Regarding claims 28, 29, and 32**, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location



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(Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7, Line 44 - Column 8 Line 5).

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links that contain further specific data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

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**Regarding claim 30**, De Vries teaches sending promotional information to users (Column 11, Lines 44-54). Should a user and another user both be nearby, they would get the same promotional message and this reads on the claim language.

**Regarding claims 33 and 34**, De Vries teaches instant messaging clients as interacting over the Internet (Column 1, Lines 46-50).

**Regarding claim 35**, De Vries teaches storing a name database (Column 13, Lines 31-46).

**Regarding claim 36**, De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

4. **Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179) in view of Callegari (U.S. Pub No. 2003/0004743).**

Regarding claim 31, De Vries teaches subscribing to alert and notification messages (Column 5, Lines 60-61). De Vries does not appear to specify linking a user to a website in order to subscribe. Callegari teaches a multi-user location-sharing system using buddy lists (Paragraph 0080) in which users are directed to the website of a merchant in which they are visiting (Paragraph 0108). It would have been obvious to one having ordinary skill in the art at the time the invention was made to direct a user to a merchant's website to subscribe to further

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notifications in the interest of having that user further view more advertising for the merchant in the form of the website.

***ALTERNATIVE Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Treyz (U.S. Patent No. 6,587,835).** Treyz teaches a method of advertising that includes all of the limitations recited in the above claim.

**Regarding claim 1**, Treyz teaches storing presence information for a business on a client system device (Figure 16) and sending this information to the wireless device of a user as directions (Figures 42 and 43). The presence information is received upon the clicking of a button (Figure 44, Reference 508). The claim recites the user as an “instant messaging user”, however the claim does not require any instant messaging client to be installed on the device. The user merely has to be someone who is capable of using instant messaging in any context. Further, the device of Treyz receives “instant messages” (Figure 55), and this makes the user an “instant messaging user”.

### ***Response to Arguments***

The affidavits filed on 1/30/2008 have been reviewed and accepted.

Thus, the Mitsuoka reference has been removed as prior art under 103(c). The rejection over 102(e) listed above is merely provided to demonstrate the broad nature of claim 1.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following reference is cited to further show the state of the art with respect to location based presence in an instant messaging client:

U.S. Patent No. 6,714,791 to Friedman

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BEKERMAN whose telephone number is (571)272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. B./  
Examiner, Art Unit 3622

/Eric W. Stamber/  
Supervisory Patent Examiner, Art Unit 3622